

Amdt. dated December 27, 2004
Reply to Office action of Nov. 3, 2004

Serial No. 09/726,268
Docket No. AUS920000344US1
Firm No. 0072.0033

REMARKS/ARGUMENTS

1. The Claims Comply with 35 U.S.C. §112, par. 2

The Examiner rejected claims 6, 18, and 30 as indefinite (35 U.S.C. §112, par. 2) for having an element, the "access time rating", that lacks antecedent basis. Applicants amended these claims to remove this requirement, thereby correcting the antecedent basis error.

The Examiner rejected independent claim 1 as indefinite for including a phrase that is not clearly understood. Applicants amended claim 1, and also independent claims 13 and 25, to remove the unclear phrase.

Applicants request the Examiner to enter these amendments because they do not alter the claims in a manner that would necessitate further searching and to expedite prosecution.

2. Claims 1, 3-7, 12-14, 16-19, 24-26, 28-31, and 36 are Patentable Over the Cited Art

The Examiner rejected claims 1, 3, 7, 12, 13, 15, 19, 24-25, 27, 31, and 36 as obvious (35 U.S.C. §103(a)) over Merriam (U.S. Patent Publication 2003/0195960) and Barrick (U.S. Patent No. 6,625,647). Applicants traverse.

Under 35 U.S.C. §103(c), subject matter which qualifies as prior art under 35 U.S.C. §102(f), which includes Merriam, shall not preclude patentability where the subject matter, i.e., Merriam, and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants submit that at the time the present invention was made, the claimed invention and Merriam were owned or subject to an obligation of assignment to International Business Machines Corp. (IBM). Thus, under 35 U.S.C. §103(c), Merriam cannot be used in an obviousness rejection of the claims of the present application.

The Manual of Patent Examination and Procedure (MPEP) makes this rule clear:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

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This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999....

MPEP, Sec. 706.02(1)(1), pg. 700-51(8th Ed., Rev. 2, May 2004).

Accordingly, under 35 U.S.C. §103(c), Applicants request withdrawal of the obviousness rejection with respect to claims 1, 3, 7, 12, 13, 15, 19, 24-25, 27, 31, and 36 in view of Merriam.

The Examiner rejected claims 4-6, 9, 16-18, 21, 28-30, and 33 as obvious (35 U.S.C. §103(a)) over Merriam and Barrick in view of Barrett (U.S. Patent No. 5,727,129). Applicants traverse for the reasons discussed above because at the time the present invention was made, the claimed invention, Merriam and additionally Barrett were owned or subject to an obligation of assignment to IBM. Accordingly, under 35 U.S.C. §103(c), Applicants request withdrawal of the obviousness rejection with respect to claims 4-6, 9, 16-18, 21, 28-30, and 33.

The Examiner rejected claims 11, 23, and 35 as obvious over Barrett and Barrett et al and Berstis (U.S. Patent No. 6,092,100). Applicants traverse for the reasons discussed above because at the time the present invention was made, the claimed invention, Merriam and additionally Berstis were owned or subject to an obligation of assignment to IBM. Accordingly, under 35 U.S.C. §103(c), Applicants request withdrawal of the obviousness rejection with respect to claims 11, 23, and 35.

The Examiner rejected claims 10, 22, and 34 as obvious over Merriam, Barrick and Barrett and in view of Killian (U.S. Patent No. 6,438,592). Applicants traverse for the reasons discussed above because at the time the present invention was made, the claimed invention, Merriam and additionally Berstis were owned or subject to an obligation of assignment to IBM. Accordingly, under 35 U.S.C. §103(c), Applicants request withdrawal of the obviousness rejection with respect to claims 11, 23, and 35.

Conclusion

For all the above reasons, Applicant submits that the pending claims 1, 3-7, 9-13, 15-19, 21-25, 27-31, and 33-36 are patentable over the art of record. Applicants have not added any claims. Nonetheless, should any additional fees be required, please charge Deposit Account No. 09-0447.

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The attorney of record invites the Examiner to contact him at (310) 553-7977 if the Examiner believes such contact would advance the prosecution of the case.

Dated: December 27, 2004

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